

**REMARKS**

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1 and 3-8 are now present in this application. Claims 1, 4, 6 and 7 are independent. Claim 2 is canceled, claims 1, 3, 4, 6 and 7 are amended, and claim 8 is added. No new matter is involved. Support for the amendments is found throughout Applicant's originally filed disclosure, including the original claims, drawings and main body of the specification and, for example, page 13, lines 13-19.

Reconsideration of this application is respectfully requested.

**PREMATURE FINAL REJECTION AND ENTRY OF AMENDMENTS**

The Office Action states that Applicant's amendment necessitated the new grounds of rejection presented in the outstanding Office Action. Applicant respectfully disagrees. The only amendments made to claims 1, 4 and 5 were made to overcome the rejection under 35 U.S.C. §112, second paragraph.

In particular, the terminology "multi-stage" was replaced with --multiple loading stages of the disk--, and "optical disk" was changed to --optical disk driver--.

These changes did not affect the scope of the claims in any way. Rather, they merely made the claims clearer to understand.

Because these changes did not necessitate the entirely new grounds of rejection, the outstanding Office Action was prematurely made final.

Applicant respectfully requests that the finality of the August 27, 2004 Office Action be withdrawn.

Moreover, with the finality of the outstanding Office Action withdrawn, the Amendments are entitled to be entered per 37 C.F.R. §1.111.

#### **RE-SETTING OF RESPONSE PERIOD**

The Office Action applies, for the first time, a "Tonegawa et al." reference, but does not list a Tonegawa et al. reference on a Form PTO-892 or otherwise identify the reference. As a result, the Office Action is incomplete and could not be responded to until this reference was identified.

Applicant's undersigned representative informed Examiner Psitos of this problem on November 15, 2004. Examiner Psitos kindly faxed a copy of the Tonegawa reference on which the rejection of claims 1-2 is based. The Tonegawa reference faxed to Applicant's undersigned representative is U.S. Patent 5,878,005.

Applicant thanks Examiner Psitos for promptly identifying this reference and providing Applicant with a copy of this reference.

Applicant requests that the Tonegawa et al. reference be listed on a Form PTO-892 in the next Office Action.

Applicant also requests that the time to respond to this Office Action be reset to expire one month from the aforementioned November 15, 2004 date on which the Tonegawa reference was identified and a copy thereof provided to Applicant's undersigned representative. This is consistent with the guidance set forth in MPEP §710.06. Accordingly, Applicant respectfully requests that the time to respond to the outstanding Office Action be extended to expire on December 15, 2004.

Examiner Psitos indicated that Applicant was entitled to have the response due date of the Office Action extended.

**REJECTIONS UNDER 35 U.S.C. §103**

Claims 1, 4, 5, 6 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,878,005 to Tonegawa in view of JP 60-136059 further considered with U.S. Patent 4,688,124 to Scribner. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

It is well settled that a rejection under 35 U.S.C. §103 cannot properly be based on speculation but must be based on objective factual evidence of record. See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). See, also, In re GPAC, Inc., 35 USPQ2d

1116 at 1123 (Fed. Cir. 1995) and Ex parte Haymond, 41 USPQ2d 1217 at 1220 (Bd. Pat. App. & Int. 1996).

A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Moreover, allegations of motivation to modify a reference that are in the form of broad generic conclusions unsupported by objective factual evidence and, standing alone, are not "evidence" of proper motivation to combine these references. See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

None of the applied references disclose or suggest the combination of features recited in claims 1, 4, 6 or 7, including (1) the step of discriminating loading status of an optical disk during multiple loading stages of the disk on the basis of sensing signals respectively outputted from the plurality of optical sensors and from a disk loading switch for sensing whether the optical disk has been completely loaded, or (2) means for discriminating loading status of an optical disk during multiple loading stages of the disk on the basis of sensing signals respectively outputted from the plurality of optical sensors and from a disk loading switch.

Furthermore, none of the applied references discloses the combination of features recited in claim 3 or 8, including, for example, the recitation in claim 8,

wherein the determining step includes determining that the values of the sensing signals respectively outputted from the plurality of optical sensors and the disk loading switch are maintained for more than a predetermined time.

Tonegawa is not even alleged to include such a feature.

The English language Abstract of JP 60-136059 only appears to disclose a single index sensor 6 and does not disclose discriminating loading status of a disk during multiple loading stages.

Scribner discloses that if sensor 158 does not detect the leading edge 20a of the floppy disk 20 shortly after detection by the sensor 160, then rollers 58 and 60 are stopped and a signal given that the loading mechanism is jammed. So, even if these references were properly combined, the reference combination would not render the claimed invention obvious. This is most definitely not a disclosure of determining that the values of the sensing signals respectively outputted from the plurality of optical sensors and the loading switch are maintained for more than a predetermined time. Scribner does not disclose any predetermined time period and definitely does not disclose maintaining those signals for more than a predetermined time.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention.

Furthermore, exactly how the primary reference is to be modified by the secondary reference and/or how that combination is to be modified by the

tertiary reference is not set forth in any detail. Moreover, whereas Scribner discloses two sensors associated with its jam detection, i.e., sensors 158 and 160, JP 60-136059 only discloses one such sensor 6. Furthermore, whereas JP 60-136059 ejects a misloaded disk, Scribner contains no such teaching or ejecting a misloaded disk. Applicant is given no indication of what features of the base reference are modified by what features of the secondary and tertiary references, and how those unspecified features are to be modified.

Accordingly, this rejection is fundamentally flawed and denies Applicant the fundamental substantive and procedural due process required to be given patent applicants under the Administrative Procedures Act. See in this regard, In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Reconsideration and withdrawal of this rejection is respectfully requested.

Claims 2 and 3 stand rejected under 35 U.S.C. §103(a) as being unpatentable over “the art as applied to claim 1 above,” and further in view of U.S. Patent 5,191,569 to Kurosawa et al. (hereinafter, “Kurosawa”). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Initially, Applicant respectfully submits that the Tonegawa - JP 60-136059 - Scribner reference combination does not render obvious claim 1, from which

claims 2 and 3 depend, for the reasons stated above. Accordingly, even if it were proper to modify the aforementioned reference combination using Kurosawa, the further modified reference combination would not render the invention recited in claims 2 and 3 obvious.

Moreover, Kurosawa merely discloses a single detecting member 400 to detect the presence or absence of a disk in each of the magazine trays – Figs. 8 and 17 and associated disclosure in the specification, and teaches that it eliminates jamming of disks – see col. 5, lines 10-14.

Applicant cannot find multiple stage detection of disks in Kurosawa or detection of a jam or ejection of a jammed disk. In fact, as noted above, Kurosawa indicates that its device eliminates jamming of disks.

Accordingly, one of ordinary skill in the art would not be motivated to look to Kurosawa for jam detection features, let alone to look to Kurosawa to use a disk completely loaded detection feature to determine the existence of a disk jam, as recited.

As a result, the Office Action fails to provide proper motivation to look to Kurosawa to modify the aforementioned reference combination, which does not render the claimed features obvious at least for the reasons stated above regarding the traversal of the rejection of claim 1.

Further, with respect to claim 3, which recites the predetermined time feature for determining that a disk has been jammed, there is absolutely no

objective evidence of record that any of the applied references discloses such a feature. The assertion in the Office Action that the Examiner interprets the operation of the Scribner system as meeting this time limitation is pure speculation and it is improper to base a rejection on speculation. As is well settled, a rejection based on Section 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the Examiner has the initial duty of supplying the factual basis for the rejection advanced. The Examiner may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Moreover, as noted above Scribner does not disclose or suggest that when the combination of the sensing signals respectively outputted is not a value indicating a state that the disk is completely mounted and being maintained as such for more than a predetermined time, it is discriminated that the disk has been jammed, as recited.

Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.



**NEW CLAIM**

Claim 8 is added for the Examiner's consideration. Claim 8 recites a method step somewhat broader than what is recited in claim 3, reciting a predetermined time feature not disclosed in, or suggested by, any of the applied references.

**ADDITIONAL CITED REFERENCES**

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

**CONCLUSION**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone

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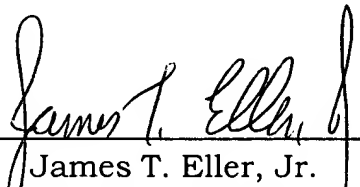
Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.


Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:   
James T. Eller, Jr.  
Reg. No.: 39,538

JTE/RJW:gf  


P.O. Box 747  
Falls Church, Virginia 22040-0747  
Telephone: (703) 205-8000